

REMARKS

Claims 1-2, 4-22 and 24-43 are pending in the present application. By this Reply, new claim 43 has been added. Claims 1, 18, 21 and 35 are independent claims.

35 U.S.C. § 103 Rejection

Claims 1, 2, 4, 9-22, 24-25 and 30-42 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. (U.S. Patent No. 6,469,796) in view of Murphy et al. (U.S. Patent No. 6,076,110) and further in view of DeHORITY (U.S. Patent No. 5,129,6396). Claims 5-7 and 26-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. in view of Murphy et al. and DeHORITY, as applied to claim 1 above, and further in view of Applicants' disclosed related art. These rejections are respectfully traversed.

Regarding independent claims 1, 18, 21 and 35, the Examiner rejects these claims by combining Leiman et al., Murphy et al. and DeHORITY. Applicants respectfully submit, however, there is absolutely no motivation to combine the references to render the claimed invention obvious.

Leiman et al. and Murphy et al. teach a method and system in which a user sends a print job, having certain print job settings, to a plurality of printers. Leiman et al. selects the devices that are suitable for carrying out the requested print job from the plurality of available devices in the network. Leiman et al. even disables or blocks the unsuitable devices, thereby excluding these unsuitable devices from the list of selectable devices. The Leiman-Murphy system present a list of selectable devices to an operator, which are able to execute the job perfectly, i.e., completely, according to the formulated requirements and print job settings. Thus, the Leiman-Murphy system is a system that searches for a device that is able to print the job exactly as required.

On the other hand, DeHORITY discloses a method and system that presents a print job, having certain print job settings, to one single printer, whether or not the printer is suitable for

executing this print job. The method of DeHority checks the suitability of this particular job with respect to the actual capabilities of the device and, depending on the configured strategy, presents the user with a choice to modify the print job settings manually, to modify the settings automatically based on a database of possible alternatives, or to cancel the job. A disadvantage of such system is that, in case the device is not suitable for the job, no print is delivered. Thus the job is adapted to suit the job to the device capabilities. DeHority sends the job to a single printer, which processes the job in the best fashion as possible. If a certain feature is not available, DeHority changes the settings such that the job is printed anyhow, i.e., possibly in a deteriorated way. Thus, the teaching of DeHority in general is to adapt a job to the capabilities of a device which is initially not suitable for the job.

One skilled in the art would recognize that the Leiman-Murphy system teaches to always make sure that a job is printed on a printer which is perfectly suitable for the job on hand. The Leiman-Murphy system even teaches to block unsuitable printers. Thus, for the Leiman-Murphy system, one skilled in the art would never search for or apply a document (such as DeHority) that teaches how to print a job on an unsuitable block device nonetheless, thereby degrading the perfect execution of the job in the Leiman-Murphy system. In other words, there is absolutely no incentive or motivation to apply DeHority's teachings in the Leiman-Murphy system. In fact, in view of the perfect execution of the job desired and provided by the Leiman-Murphy system, the teachings of the Leiman-Murphy system teach away from the application of DeHority thereto.

Furthermore, even if one skilled in the art who may be familiar with the Leiman-Murphy system would accidentally stumble upon DeHority, he would not combine these teachings as suggested by the Examiner, since DeHority is incompatible with the Leiman-Murphy system.

Therefore, the rejection is improper because the Examiner has failed to establish a proper *prima facie* case of obviousness as required. Accordingly, independent claims 1, 18, 21 and 35 and their dependent claims (for example, claims 40-42) are allowable over the prior art of record, and the rejections should be withdrawn.

New Claim

Claim 43 further define the invention of claim 21 and is thus allowable at least for the same reason that claim 21 is allowable as discussed above. These features fully supported by the original disclose, for example Figure 3C and Figure 3E.

Conclusion

For the foregoing reasons and in view of the above clarifying amendments, Applicant(s) respectfully requests the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicits an early issuance of a Notice of Allowance.

The Examiner is respectfully requested to enter this Amendment After Final, in that it raises no new issues but merely places the claims in a form more clearly patentable over the references of record. In the alternative, the Examiner is respectfully requested to enter this Amendment After Final in that it reduces the issues for appeal.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong (Registration No. 40,953) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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